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Attn: Mr. Glenton Burgess

28 November 2005

Our Ref: GH-FP4554

Your Ref: ---

Dear Mr. Burgess,

U.S. Patent Application No. 09/634,947
METHOD AND APPARATUS FOR STREAMING OF DATA
James Pei-Man She et al

I am writing to complain with regard to the standard of examination on the above case.

I am not the attorney of record for this file, but you will note on this case that the assignee is The Hong Kong University of Science and Technology. I am the local attorney in Hong Kong for the assignee. I have drafted this case and I am prosecuting this case with the assistance of US attorneys of record Buchanan Ingersoll (formerly Burns Doane, Swecker & Mathis).

I do not wish to discuss the technical details of this particular application and objections raised against it, but I am extremely disappointed in the manner of examination which has resulted in significantly increased costs for my client. In particular I would like to draw your attention to the following facts:

1. On 29 September 2004 the Examiner issued an Office Action on this case indicating that all pending claims were allowed with the exception of claim 28. Claim 28 was rejected on the basis of a single citation US 5,970,491. All other claims were explicitly stated by the Examiner to be allowable.
2. We reviewed the rejected claim 28 and the citation and considered that the rejection of claim 28 was mistaken and a response was filed by our US colleagues on 29 December 2004 arguing in favour of claim 28.
3. On 22 April 2005 the Examiner then issued a further Office Action continuing to reject claim 28 over US 5,970,491 but once again explicitly stating that all other claims pending in the application were considered to be allowable.

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4. Although we disagreed with the Examiner's continued rejection of claim 28, in order to expedite the prosecution of this case the applicant decided to abandon claim 28 to secure allowance of all other pending claims. Claim 28 was therefore deleted in response to the Office Action of 22 April 2005. Given that in two consecutive Office Actions the Examiner had indicated that all other pending claims were allowable, we then not unreasonably expected to receive the Notice of Allowance.
5. However, instead of receiving the Notice of Allowance the Examiner then issued a further Office Action dated 3 August 2005 in which claims 1 and 14 were rejected over US 5,970,491. This is the same citation that the Examiner had used in the previous two Office Action with regard to claim 28, and in both of which Office Action the Examiner had indicated that otherwise all claims were allowable.

We appreciate that the Examiner's actions are no doubt within the law, but we would submit that this is an extremely poor standard of examination. Ignoring for the moment the merits or otherwise of the objections raised by the Examiner, US 5,970,491 is not a new citation. The Examiner had issued not just one but two Office Actions indicating that other than claim 28 all pending claims were allowable. Since the Examiner had rejected claim 28 on the basis of US 5,970,491 it was not unreasonable of us to assume that the Examiner had fully considered that citation when coming to the conclusion that all other claims were allowable. For the Examiner to then decide to reject claims 1 and 14 over a reference that had been under consideration for at least the two preceding Office Actions is disgraceful. If the rejection of claims 1 and 14 over the citation had any merit it could have been raised in the Office Action of September 2004.

Does the Examiner have any concept of the increased costs to the applicant that have been incurred as a result of this poor standard of examination? The assignee is a University and as a non-profit organization costs are always an issue. Since the assignee is not based in the United States there are also increased costs since the assignee is instructing both local attorneys in Hong Kong and attorneys in the US who are handling the filing. As a ballpark estimate the cost of reviewing an Office Action, considering the form of response that we should take and filing that response can easily total US\$2,000 to 2,500 per office action.

I would be grateful for your explanation as to why the USPTO allows such a standard of examination. It is particularly ironic given that the US Government constantly berates other countries for an allegedly poor standard of IP protection, when the USPTO itself can be guilty of such practices.

I look forward to hearing from you.

Yours sincerely,



Graeme Hall

Lloyd Wise & Company

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